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Attorney Docket No.: 117-P-1345US01

Remarks

Claims 20-27 and 39-51 have been amended as shown above. Antecedent basis for the amendments may be found in the specification at, e.g., page 4, line 22 through page 6, line 2. Following entry of this amendment, claims 20-27 and 39-51 will be pending in this application.

Rejection of Claims 20-27 under 35 U.S.C. §112

Claims 20-27 were rejected under 35 U.S.C. §112, second paragraph as being indefinite on grounds that:

"It is unclear how a flooring laminate system comprises "directions for applying the intermediate coating". Appropriate clarification or amendment if required." (see the Final Rejection at page 2, numbered paragraphs 2).

Reconsideration is requested in view of the above amendments and the following further explanation.

Rejected claims 20-27 now recite an article of manufacture rather than a system. The specification includes ample directions for using the disclosed compositions in such an article of manufacture (see e.g., page 7, line 15 through page 8, line 24 and the working examples at pages 1-14) including directions for applying the intermediate coating to resilient flooring (see e.g., page 7, lines 15-24). Persons having ordinary skill in the art will readily understand whether printed matter or other instructional materials represent "directions for applying the intermediate coating to resilient flooring".

Applicants accordingly request withdrawal of the 35 U.S.C. §112, second paragraph rejection of claims 20-27.

Rejection of Claims 20-27 and 39-51 under 35 U.S.C. §102(b)

Claims 20-27 and 39-51 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,932,350 (Lauer et al.), on grounds that:

"Lauer et al. (US 5,932,350) disclose a method for tandem coating substrate, such as cellulosic substrates, with both highly crosslinked thermoset coatings and aqueous based coatings (Column 1, lines 1-9). The substrate may be coated first with the cured coating (ii) and then the highly crosslinked coating (i) which is preferably formed

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from a thermoset material that is UV curable and which before cure may be a high solids composition or a waterborne composition (Column 2, lines 31-51). The UV curable coatings, after exposure to UV radiation, produce highly crosslinked coatings. It has proved difficult to adhere water-based topcoats without the use of an intermediate coating (Column 3, lines 1-6). With regards to the stripability rating limitations, the Examiner takes the position that such property limitations must be inherently present in the coatings taught by Lauer et al. given that the chemical composition of the coatings as taught by Lauer et al. and as claimed in the instant application is identical. All limitations of the claimed invention are either disclosed or inherent in the above reference." (See the Final Rejection at pages 2-3, numbered paragraph 3).

and on the further grounds that:

"Applicants state that Lauer's coatings are "highly cross linked" and are "carbonyl functional" and that Lauer does not state that the coatings "can be stripped without damaging the floors". First, the Examiner would again like to point out that the language of the independent claim does not preclude the topcoat from being "highly cross linked" and/or "carbonyl functional". Second, Lauer's coatings must inherently be strippable "without damaging the floors" given that Lauer teaches the same coatings as claimed by the instant Applicants. Applicants further state that none of Lauer's working examples show a coated floor of the claimed invention. However, "the use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain". In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ

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423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

"Applicants have directed the Examiner to the Hei Declaration to overcome the rejection of 20-27 and 39-51 under 35 U.S.C. 102(b) as being anticipated by Lauer et al. (US 5932,350) however the Examiner would like to point out that the claims of the instant application are invention commensurate in scope with the showing in the Hei Declaration or the Specification.

"In conclusion, the above rejection is maintained for the reasons of record and the Examiner invites the Applicants to amend the claims to recite an invention commensurate in scope with the showing in the Hei Declaration and the Specification, i.e., a claim having at least a vinyl floor tile coated with a single layer of PADLOCK acrylic polymer floor finish and over coated with a two-component aqueous polyurethane composition." (See the Final Rejection at pages 3-5).

Reconsideration is requested. When applicants said that:

Lauer et al.'s coating (i) is said to be "highly crosslinked" and "preferably formed from a thermoset material" (see e.g., col. 2, lines 46-47) but *Lauer et al.* do not say that coating (i) "can be stripped without damaging the floor".

and that:

Lauer et al.'s waterbased or aqueous coating (ii) is said to be "carbonyl functional" (see e.g., col. 3, lines 9-16) and "preferably a thermoplastic or substantially uncrosslinked copolymer when it is applied (in its uncured state) to the substrate" (see e.g., col. 4, lines 38-39) but *Lauer et al.* do not say that the oven-dried coating (ii) "can be stripped without damaging the resilient flooring" or "stripped without damaging the floor".

applicants were not saying that their own topcoat (once cured or hardened) could not be "highly crosslinked" or that their own intermediate coating could not be "carboxyl functional".

Applicants were merely describing *Lauer et al.*

Applicants do not agree that *Lauer et al.*'s coatings "must inherently be strippable "without damaging the floors"" as asserted in the Final Rejection. *Lauer et al.* say that their coatings are "highly crosslinked" and they cure them using a UV line processor. A person

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having ordinary skill in the art would expect that such a coating could not be stripped from resilient flooring without damaging the flooring (see e.g., page 1, lines 10-18).

Applicants agree that “A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments”, but note that the recited standard would be applicable to a 35 U.S.C. §103 rather than a 35 U.S.C. §102 rejection. In addition, this standard must be applied fairly, including proper application of the terms “reasonably suggested” and “the art”. Applicants do not agree that Lauer et al. would be consulted by a person having ordinary skill in the relevant art. The relevant art does not involve all coating compositions or all coating applications. A person having ordinary skill in the relevant art would be interested in applying a “strippable ... finish renewal article of manufacture” to “resilient flooring”. Lauer et al. has nothing to do with strippable finishes or floors, let alone resilient flooring.

The rejected claims do not merely recite two coatings. Rejected claim 20 recites a combination of a “strippable intermediate acrylic coating in a first container”, a “polymerizable waterborne urethane or acrylate topcoat in a second container” and “directions for applying the intermediate coating to resilient flooring and the topcoat to the intermediate coating”. Claim 20 also recites that “the polymerized topcoat is less strippable than the intermediate coating when each is coated alone atop the resilient flooring”, and recites that the “polymerized topcoat is sufficiently strip agent permeable so that the topcoat and intermediate coating can be at least partially stripped from the resilient flooring in 30 minutes without damaging the resilient flooring”. Lauer et al. say nothing regarding the stripping their coatings, nothing regarding the relative strippability of their coatings and nothing regarding floors or flooring damage during stripping.

Lauer et al discuss many coating materials but do not provide any basis for selecting the combination recited in applicants’ rejected claims. For example, all of Lauer et al.’s working examples (and Lauer et al.’s preferred application mode, see col. 5, lines 57-62) involve applying two layers of Lauer et al.’s “high solids” or “highly crosslinked” coating (i) onto hardboard, sanding, UV curing and applying a layer of Lauer et al.’s waterbased coating (ii). Lauer et al. say that the highly crosslinked coating seals the hardboard surface and that the waterbased coating provides a decorative layer (see e.g., col. 1, lines 11-24 and col. 5, lines 57-65). Lauer et al.’s

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working examples and preferred application mode do not involve a resilient floor, do not involve application of coatings in the order recited in the rejected claims, and do not disclose application atop an intermediate coating of a topcoat that when polymerized is "sufficiently strip agent permeable so that the topcoat and intermediate coating can be at least partially stripped from the resilient flooring in 30 minutes without damaging the resilient flooring". Also, Lauer et al.'s sanding step would be undesirable and would not normally be employed on (and could damage) resilient flooring. Lauer et al.'s working examples and preferred application mode could not fairly be said to "reasonably suggest" the articles of manufacture recited in the rejected claims and could not fairly be said to be part of the relevant art.

As previously noted Lauer et al. also say that in another embodiment:

"the cellulosic material is a paper material such as may be typically used in a printing or packaging application. Here, the waterbased coating (ii) may first be applied to the substrate, such as in the form of an ink, and then the cured waterbased coating (ii) and substrate are both coated with the highly crosslinked coating".

"Printing or packaging" has nothing to do with resilient flooring and does not show or suggest the article of manufacture of the rejected claims. Lauer et al.'s printing or packaging embodiment could not fairly be said to "reasonably suggest" the articles of manufacture recited in the rejected claims and could not fairly be said to be part of the relevant art.

Applicants have amended the rejected claims generally along the lines recommended by the Examiner, but with some differences to avoid unfairly narrowing the claims:

Applicants' claims continue to refer to "resilient flooring" rather than to "vinyl floor tile" as recommended in the Final Rejection. Applicants note in this regard that resilient floors generally are less durable than non-resilient floors and thus are more easily damaged by aggressive removal techniques such as floor sanding or aggressive burnishing (see e.g., page 1, lines 16-17). A person having ordinary skill in the art would readily understand from applicants' specification and from the Hei Declaration that the claimed articles of manufacture could provide a strippable floor finish not only on vinyl floor tiles but also on other resilient floors such as the "vinyl flooring, vinyl composite flooring, and synthetic sports floors" discussed at page 4, lines 17-18 of the specification.

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Applicants' amended claims refer to a strippable intermediate "acrylic" coating (which may be made from one or many layers) rather than a "single layer of PADLOCK acrylic polymer floor finish" as recommended in the Final Rejection. A person having ordinary skill in the art would readily understand from applicants' specification and from the Hei Declaration that the claimed articles of manufacture could provide a strippable floor finish using not only a single layer of PADLOCK acrylic adhesive but also using more than one layer of any of a variety of acrylic polymers including those discussed or exemplified at page 4, line 22 through page 5, line 11, page 7, lines 19-20 and page 8, lines 31-32.

Applicants' amended claims refer to a polymerizable waterborne "urethane or acrylate" topcoat rather than a "two-component aqueous polyurethane composition" as recommended in the Final Rejection. Applicants note in this regard that the topcoats in Examples 1-3 and Finish 2 through Finish 4 in the Hei Declaration contain urethane and acrylate monomers. A person having ordinary skill in the art would readily understand from applicants' specification and from the Hei Declaration that the claimed articles of manufacture could provide a strippable floor finish not only by using a two-component aqueous polyurethane composition but also by using a UV-curable, thermally curable, photopolymerizable or other urethane or acrylate waterborne topcoat including those discussed or exemplified at page 5, line 24 through page 6, line 18, in Examples 1-3 and in the Hei Declaration.

Applicants accordingly request withdrawal of the 35 U.S.C. §102(b) rejection of claims 20-27 and 39-51 as being anticipated by Lauer et al.

Conclusion

Applicants have made an earnest effort to overcome the rejections and have amended their claims as invited by the Examiner, with some changes to avoid unfairly narrowing the claims.

Lauer et al.'s compositions do not show and could not fairly be said to "reasonably suggest" the articles of manufacture recited in the rejected claims and could not fairly be said to be part of the relevant art.

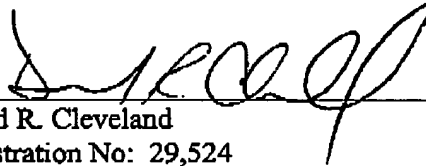
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Withdrawal of the Final Rejection and passage of the application to the issue branch are requested. The Examiner is encouraged to telephone the undersigned attorney at 612-331-7412 to discuss any unresolved questions regarding this application.

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